IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application:	09/944,676	Examiner:	Mosser, Kathleen M
Filed:	August 31, 2001	Art Unit:	3713
Inventor:	Burgin, et al.	Atty Ref.:	1160215-0538115
Title:	**SYSTEM AND METHOD FOR AUTOMATED END-USER SUPPORT**		

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In support of Applicants' appeal, filed September 14, 2007, relating to the above-captioned patent application ("Application"), please consider the following.

I.   Real party in interest.

The real parties in interest for the present application are Finali Corporation and Convergys Customer Management Group, Inc. Finali Corporation is the assignee of record per an assignment executed, on August 31, 2001, by inventors Daniel K. Burgin, Scott M. Gosling, David L. Young, and William R. Watler. Finali is a wholly-owned subsidiary of Convergys Customer Management Group, Inc.

II.   Related appeals and interferences.

To the best of Applicants' knowledge, there are no appeals or interferences which would directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal. Applicant notes, however, that a decision issued on October 18, 2007, on a Request for a Pre-Appeal Review ("Pre-Appeal"), for the present application's sibling, U.S. Application Serial No. 09/944,836. Copies of the brief in support of said Pre-Appeal and the decision issued by the Panel are included in the Appendix.

III.   Status of the claims.

Claims 1-24 were originally filed in the present application.

Claims 1-36 were cancelled.

Claims 37-56 are currently pending in the present application and are under final rejection. Claims 37-56 are the subject of the present appeal and are set forth in the Appendix (VIII) of this Brief.

IV.   Status of amendments.

Prior to the final rejection in this application, amendments were submitted on December 7, 2005. These amendments have been entered. No amendments have been submitted since then in this application.

V.   Summary of Claimed Subject Matter.

Claims in the present application improve web-based customer support by minimizing the costs associated with live agents while retaining customers through an interactive, automated help session that monitors ongoing actions by the end-user. *See*, Application at [0008], [0011], [0040-0043] and Figures 6-7. An automated help session provides co-browsing through an automated agent that is displayed in the end-user's browser window in a second frame. *See,*

Application at [0011]. A browser can simultaneously display unrelated documents in its various windows and frames, however, certain security measures prevent "the free flow of data and event information" between frames . *See,* Application at [0040]. Embodiments of the present invention circumvent this "consistent page domain security requirement" to reduce the costs associated with live support while providing an automated, interactive help session. *See,* Application at [0023] and [0041].

A. Grouping of Claims

Applicant suggests the following grouping of claims for the present appeal:

Group I: Claims 37-52, 54 and 56.

Group II: Claim 53.

Group III: Claim 55.

The arguments for why these groups of claims are separately patentable are set forth in detail in the Argument portion of this brief.

B. Antecedent Basis

Claims 37, 45, and 53 are supported by, but not necessarily limited in scope by, the disclosure of paragraphs [0012], [0023], and [0038-0045], among others, in the present specification as originally filed. Claim 55 is supported by, but not necessarily limited in scope by, the disclosure of paragraphs [0038] and [0042]-[0043], among others, in the present specification as originally filed.

C. Concise Summary of Claim Groupings

Group I is directed to providing an automated help session which is presented to an end-user via a second frame displayed within a single web page on the end-user's computer wherein the second frame monitors navigation events/locations of the end-user within the first frame.

The second frame is associated with a domain separate/distinct from the domains associated with both the end-user's computer and the first frame.

Group II is similar to Group I but additionally, explicitly references the existence of the consistent page domain security requirement between the two frames contained within the single Web page and the passing of data between those two frames.

Group III is directed to masking web addresses to facilitate the monitoring of navigation events/locations of the end-user within the first frame by the second frame within a single Web page.

VI.   Grounds of Rejection to be Reviewed on Appeal

The following references have been relied on by the Examiner in formulating the rejections:

U.S. Publication No. 2002/0130895 (Brandt),

U.S. Patent 6,256,620 (Jawahar),

U.S. Patent 6,694,314 (Sullivan).

Claims 37-54 and 56 (Groups I & II) are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Brandt in view of Jawahar. Claim 55 (Group III) is rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Brandt in view of Jawahar and Sullivan.

The patentability of the suggested claim groupings is addressed extensively in the brief herein. None of the references cited by the Examiner teach or suggest the use of an automated help session presented in a dual-frame format on an end-user's browser wherein a second frame monitors end-user navigation in a first frame after the initiation of the session. Nor do the cited references teach or suggest the use of masking to circumvent the consistent page domain security requirement.

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The Brandt reference teaches an automatic pop-up window based on data existing prior to the initiation of the help session. The Jawahar reference teaches live end-user support. Finally, the Sullivan reference does not teach a masking technique. Therefore, even in combination, these references do not teach or suggest the claims of the present application.

VII. Argument

A. The Specification provides an Implicit Definition for the Term *Domain*

The Examiner contends that the specification fails to provide a definition regarding the term domain. *See,* June 2007 OA at 5. This is incorrect. "[W]here no explicit description of a generic invention is to be found in the specification[,] ... mention of representative compounds may provide an implicit description upon which to base generic claim language." In re Robins, 429 F.2d 452, 456-57, 166 USPQ 552, 555 (CCPA 1970).

The term domain is implicitly defined in the specification within the context of one of the problems solved by embodiments of the invention: the "consistent page domain security requirement". *See*, Application at [0038, 0041]. The definition[1] proffered by Applicant in the Response to Office Action dated March 17, 2006, is consistent with this implicit definition: "A group of computers that are administered as a unit ….on the Internet, this term refers to all the computers that are collectively addressable within one of the four parts of an IP address. For example, the first part of an IP address specifies the number of a computer network. All the computers within this network are part of the same domain."

The Examiner's misunderstanding of this term appears to be at the root of a number of the rejections in the current application (including, but not limited to, the discussion in VII-B-1-b). Therefore, Applicant requests that the Board use the definition offered above, which is supported by the implicit usage of the term "domain" in the specification for the present appeal.

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B. Rejection Under 35 USC 103(a) over Brandt and Jawahar

1. Claims 37-52, 54 and 56

Claims 37-52, 54 and 56 were erroneously rejected under 35 U.S.C. §103(a) as being unpatentable over Brandt et al. (US 2002/0130895) in view of Jawahar et al. (US 6,256,620).

Applicants note that under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest <u>all of the limitations</u> of a claim. Overall, three basic criteria must be met in order to establish a *prima facie* case of obviousness.[2] First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or <u>in the knowledge generally available to one of ordinary skill in the art</u>, to modify the reference or to combine reference teachings. Finally, the art must carry a reasonable expectation of success if the combination or modification is made. The recent Supreme Court decision in <u>KSR International Company v. Teleflex Incorporated</u>, 127 S. Ct. 1727 (2007), the Court stated that a court must determine whether an alleged invention "is more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." The Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in <u>KSR International Co. v. Teleflex Inc.</u>, which were published by the USPTO, expounded on this by stating that "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." *See*, Federal Register - Vol. 72, No. 195 (October 10, 2007) at 57528

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[1] *Webster's New World Computer Dictionary, 9th ed.*
[2] MPEP § 2143.

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("USPTO KSR Guidelines"). These guidelines further stated that, "in the case of a claim to a combination, applicants may submit evidence or argument to demonstrate that one of ordinary skill in the art could not have combined the claimed elements by known methods (e.g., due to technological difficulties)." *Id.* at 57534.

The combination of Brandt and Jawahar do not teach <u>all of the limitations</u> of independent claims 37 and 45. The Examiner concedes in the Office Action dated June 19, 2007, ("June 2007 OA"), that Brandt fails to teach the following elements:

- Displaying the first frame and the second frame in a single web page at the user computer (Claims 37, 45);

- That the user's computer, first Internet domain, and second Internet domain are separate (Claims 37, 45).

Applicant also adds to this list:

- Brandt does not teach providing an <u>automated</u> help session <u>comprising monitoring</u> a plurality of <u>subsequent navigation locations/events</u> initiated by the end-user in the first frame (Claims 37 and 45).

The Jawahar reference does not provide these missing elements. Therefore, even in combination with Brandt, Claims 37 and 45 are not rendered obvious. Each of these are discussed in the following sections.

a. *Jawahar Does Not Teach Displaying the First Frame and the Second Frame in a Single Web Page at the User Computer*

The June 2007 OA contends that Jawahar teaches "the use of multiple frames within a web-browser, including one indicating the help session and the other representing browser location" in at least Col. 12: 21-64.

To make this rejection the Examiner has isolated a component of a claim limitation, taken that component out of context, and applied Jawahar to that isolated component.

In the first place, the entire context of the claim must be considered. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Finally, an argument regarding obviousness of a claim may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

Please consider these limitations in their proper context within claims 37 and 45:

37.   A computerized method for providing user support, the method comprising:
    … a **first frame originating from a first domain** to a **second frame originating from a second domain**, wherein the first domain and the second domain are separate from the end-user computer; …initiating an automated **help session in the second frame, … monitoring** one or both of:
> (i)   a plurality of **subsequent navigation locations** of the end-user within the first frame, or
> (ii)   a plurality of **subsequent navigation events** initiated by the end-user within the first frame,

    … and **displaying the first frame and the second frame in a single web page at the end-user computer**.

45.   A computerized method for providing user support, the method comprising:
    … **a first frame** of a Web page **originating from a first Internet domain** to a **second frame** of the Web page **originating from a second Internet domain**, wherein the first Internet domain and the second Internet domain are distinct from the end-user computer; …**providing a help session in the second frame** … compris[ing] one or both of:
> (i)   **monitoring** a plurality of **subsequent navigation locations** of the end-user within the first frame, or
> (ii)   **monitoring** a plurality of **subsequent navigation events** initiated by the end-user within the first frame; and

    displaying the first frame and the second frame in the Web page at the end-user computer.

The first frame originates from first domain/Internet domain and the second frame originates from a second domain/Internet domain. *See*, Application at Claims 37 and 45. Furthermore, these domains are separate from the end-user computer. *Id.* While Jawahar does teach the use of multiple frames within a web-browser, it <u>does not</u> teach that those multiple frames (e.g., web page at frame 192 and text chat window at frame 194) originate from a second domain separate from the first domain and the end-user's computer. With regard to the other frames discussed in the cited section (e.g., various system performance data, supervisor messaging system, scripts, etc.) these are not even displayed to the end-user. Therefore, they do not fulfill the claim language "displaying the first frame and the second frame in the web page at the end-user computer." *See*, Claims 37 and 45.

Additionally, the automated help session in the second frame must be able to monitor a plurality of subsequent navigations. *See*, Application at Claims 37 and 45 and [0041]. Nothing in Jawahar teaches that its frames can communicate in this manner. In fact, Jawahar teaches an entirely different communication model at Col. 7: 25-48 wherein, if a customer using browser application 78 changes information on a web page by entering information on a form, the information may be communicated to the agent's browser application 72. *See, In re Geisler*.

The Examiner attempts to graft Jawahar onto Brandt to create the presently claimed invention because Jawahar allows co-browsing between an agent's computer and an end-user's computer. This is not the same thing as presenting a help session in a separate frame on the end-user's computer and having the browser frame and the help frame communicate with one another. Looking at Jawahar, Figure 2, this communication can only take place through the intermediary communication of control server 64. No such intermediary is required in the Claims 37 and 45 because the automated help session, in the <u>second frame,</u> in a single web page

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of the end-user computer, monitors subsequent navigation by the end-user. Indeed, without this direct communication between the frames on the end-user's computer, there would be no need to circumvent the consistent page domain security requirement discussed previously and within the specification of the present Application.

Thus, Jawahar does not teach displaying the first frame and the second in a single web page at the user computer as those limitations are defined in the context of Claims 37 and 45.

> **b.** ***Jawahar does not teach that separate domains are associated with the frames by showing that the user's computer, first Internet domain, and second Internet domain are separate.***

The June 2007 OA contends that "separation of the various features of Jawahar is taught in at least Figure 2." Again, the Examiner has isolated this limitation to the point that is rendered nearly meaningless. The entire claim context must be considered. *See*, In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Once this is done, "to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In claims 37 and 45, a first frame originating from a first domain and second frame originating from a second domain are separate/distinct from the end-user computer. Nothing in Figure 2 even illustrates the existence of frames much less that the originating domains of those frames is separate/distinct from the end-user computer. Finally, for the reasons stated in the previous section, nothing in Figure 2 or anywhere else in Jawahar teaches that these frames can

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communicate with one another. The mere existence of an agent system, web server, and customer browser does not teach that separate domains are associated with separate frames.

Thus, Jawahar neither expressly or impliedly suggests the claimed inventions because nothing in that reference discusses the originating domains for the frames used in that system. In fact, the communication model taught by Jawahar teaches away from the present invention. Therefore, Jawahar does not teach that separate domains are associated with the frames.

> c. *Jawahar does not teach providing an <u>automated</u> help session comprising monitoring a plurality of <u>subsequent navigation</u> locations/events initiated by the end-user in the first frame. Furthermore, the combination of Jawahar's monitoring of subsequent navigation with Brandt's automated help session is not reasonable.*

The combination of Brandt and Jawahar do not teach an **<u>automated</u>** help session <u>comprising monitoring</u> a plurality of <u>subsequent navigation locations/events</u> initiated by the end-user in the first frame as claimed in Claims 37 and 45.

The prior art reference or combination of references must teach or suggest <u>all of the limitations</u> of a claim. MPEP 2143.03. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." <u>Ex parte Clapp</u>, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Finally, such secondary considerations as long felt but unsolved needs might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *See,* <u>Graham v. John Deere</u>, 383 U.S. 1, 148 USPQ 459 (1966).

Brandt teaches an automated help session which displays a help file based on the current web paged viewed by the user. *See*, Brandt at [0036]. Brandt does not, however, teach any further monitoring of subsequent navigation as is claimed in the present application.

Jawahar, according to the Examiner, teaches "an online system for providing **live support** to an end-user." *See*, June 2007 OA at page 3. This is contrary to the stated goal of the invention which strives to minimize the dependence upon live support to make e-commerce more cost-effective. *See*, Application at [0008].

Furthermore, the present invention is more than a mere combination of the automated system of Brandt with the monitoring capacity of Jawahar because of the existence of a particular difficulty in providing and automated help session utilizing multiple frames, originating from different domains from the end-user, that track subsequent navigation of the end-user in the first frame associated with the first domain. None of the rationales offered by the USPTO KSR Guidelines to support an obviousness rejection apply to this Application. *See*, USPTO KSR Guidelines at 57529 ("USPTO Rationale #X). These rationales include:

1. Combining prior art elements according to known methods to yield predictable results;
2. Simple substitution of one known element for another to obtain predictable results;
3. Use of known technique to improve similar devices (methods, or products) in the same way;
4. Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
5. ''Obvious to try''—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
6. Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
7. Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *Id.*

As stated in the Application, the existence of the consistent page domain security requirement presented an unsolved problem in the industry. *See*, Application at [0040-0041]. Specifically, it would not have been possible to simply combine these features in the present

application due to a unsolved problem in the computer industry – how to circumvent the consistent page domain security requirement. Per the USPTO's own guidelines, a rejection based on obviousness may be contested if one of ordinary skill in the art could not have combined the claimed elements by known methods (e.g., due to technological difficulties). *See*, Federal Register - Vol. 72, No. 195 (October 10, 2007) at 57534. The technological difficulty here was the existence of the consistent page domain security requirement.

Therefore, due to this technological difficulty, it would not have been possible to combine the prior art elements to yield a predictable result. *Contra,* USPTO Rationale #1. Also, because of the consistent page domain security requirement, simple substitution of the elements of Jawahar with the elements of Brandt would not have achieved the desired result of allowing the frames to communicate with one another. *Contra*, USPTO Rationale #2. Use of the techniques of Brandt and Jawahar in concert would not have improved the state of the art to produce the current claims due to the consistent page domain security requirement. *Contra*, USPTO Rationale #3. There is no technique described in either Brandt or Jawahar which could have been applied to circumvent the consistent domain page security requirement. *Contra*, USPTO Rationale # 4. It would not have been "obvious to try" to combine Brandt and Jawahar for at least the reason that it simply would not have produced an invention covered by the currently pending claims. *Contra*, USPTO Rationale #5. Nothing in either Brandt or Jawahar discusses the problem of circumventing the consistent page domain security requirement so neither of these pieces of prior art would have prompted one of skill in the art to attempt to modify them to produce the current invention. *Contra*, USPTO Rationale #6. Finally, as has been discussed extensively in this brief, according to the traditional test, there is no teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the

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prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *Contra*, USPTO Rationale #7.

Therefore, it would not have been obvious to an artisan of ordinary skill to combine the features of Brandt and Jawahar to produce the current invention due to the existence of this problem and the Examiner has further not provided any line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the references and the discussed difficulties in combining such references.

2. Conclusion on the Rejection of Claims 37-52, 54 and 56 Under 35 USC 103(a) over Brandt and Jawahar

Applicants therefore submit that the combined art of record fails to teach or suggest all of the limitations recited in each of claims 37 and 45 in accordance with MPEP 2143.03. Accordingly, Applicants respectfully submit that the combined art of record fails to render each of claims 37, 45, and their dependent claims obvious in accordance with MPEP 2143, and respectfully request that the rejection be withdrawn.

3. Claim 53

Applicant reiterates and incorporates by reference all of the arguments relating to Claims 37 and 45 as these also apply to Claim 53. Additionally, the Examiner conceded that Brandt failed to disclose that the "browser is subject to the consistent page domain security requirement (Claim 53)."

> 53.   A computerized method for providing user support at an end-user's computer, the method comprising:
> passing, at the end-user's computer, a navigation event from a first frame originating from a first Internet domain to a second frame originating from a second Internet domain, wherein the first frame and the second frame are contained within a single Web page that is **subject to a consistent page domain security requirement ….**

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The Examiner contended, however, that Jawahar taught this limitation by teaching the "user of either the Netscape or the Internet Explorer browser (Jawahar, Col. 6: 8-21), both of which are known to operate under the consistent page domain security when implemented in a Windows environment."

Applicant does not comment on the operation of Netscape or Internet Explorer here. Applicant does reiterate, however, that the entire context of the claim must be considered. *See*, In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Nothing in Jawahar is directed at providing an automated help session by displaying two frames each originating from different domains than the end-user's computer and each other that are capable of communicating with one another after the initiation of the automated help session. As described above, Jawahar follows a communication model that requires the go-between of the control server 64 (See, Jawahar, Col. 7: 25-48 and Figure 2) so there is no need for the live agent of Jawahar to circumvent the consistent page domain security requirement.

Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations recited in each of claim 53 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to render claim 53 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

C. Rejection Under 35 USC 103(a) over Brandt, Jawahar, and Sullivan

1. Claim 55

Claim 55 was erroneously rejected under 35 U.S.C. §103(a) as being unpatentable over Brandt in view of Jawahar in view of Sullivan.

55. The method of claim 37, wherein the first domain is associated with a first address, wherein the second domain is associated with a second address, the method **further comprising masking one or both of the first or second**

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addresses to create an appearance that the first and second addresses are the same address [emphasis added].

Applicants note that under MEP 2143.03, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest <u>all of the limitations</u> of a claim.

The Examiner concedes that the combination of Brandt and Jawahar do not teach "masking either a first or second address to create the appearance that the first and second address are the same address." The Examiner then contends that this feature is taught by Sullivan at 7: 31-44.

Applicant addressed why Sullivan was insufficient to support this rejection in the Response to the Office Action dated March 17, 2006 (March 2006 OA). The Examiner did not address these arguments in the June 2007 OA. Therefore, Applicant reiterates those arguments here. Applicants submit that the limitations of, "where the first domain is associated with a first address," and the second domain is associated with a second address, masking one or both of the first or second addresses to create the appearance that the first and second addresses are the same address, as recited in claim 55, provides an additional point of novelty which can be used to distinguish that claim from the prior art of record. Applicants assert that the section of the prior art cited by the Examiner as teaching those limitations, lines 31-44 of column 7 of US 6,694,314 ("Sullivan"), does not teach or suggest the limitations of claim 55. In support of that assertion, applicants note that lines 31-44 of column 7 of Sullivan teach maintaining security throughout a single logical session comprised of multiple TCP sessions. By contrast, applicants note that the address masking of claim 55 is designed to *circumvent* the consistent page domain security requirement, not to maintain security, as taught in Sullivan. This contrast can be brought into sharp relief by comparing paragraph 38 of the specification as originally filed, which states that

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"to circumvent the consistent page domain security requirement, the annotation server 200 masks the content from the content provider 115 so that it appears to originate from the same domain as the automated agent (step 275)" with lines 39-40 of column 7 of Sullivan, which states that "a given data set is preferably sealed to restrict access to the data to those having proper credentials." Therefore, applicants assert that the prior art of record does not teach the novel limitations of claim 55, and respectfully request that the rejection of claim 55 be withdrawn, and that that claim be allowed.

D. Conclusion on Rejections Under 35 USC 103(a)

With regard to the combination of references which the Examiner has made in order to justify the rejections under 35 U.S.C. §103, the Examiner has isolated and taken out of context various components of the individual elements which make up the present invention to render the current rejections. The Examiner then relies on the following prior art references which, even in combination, do not teach all of the limitations of the present claims. Specifically,

1. Brandt only discusses an automated system without any kind of subsequent monitoring after the initiation of the automated help session;

2. Jawahar does not contain any of the cited limitations discussed above when those limitations are put into their proper overall context;

3. Sullivan does not even discuss the limitation that the Examiner offers it for to render Claim 55 obvious. Furthermore, Examiner failed to address specific arguments raised in the response prior to the current office action.

For the reasons set forth above, it is respectfully submitted that the claims currently pending in the present application meet the requirements of 35 U.S.C. §103(a). Accordingly, it

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is respectfully requested that the Examiner's rejections be reversed and that the claims currently

pending in the present application be indicated as allowable.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

37.   A computerized method for providing user support, the method comprising:

passing, at an end-user computer, a navigation event from a first frame originating from a first domain to a second frame originating from a second domain, wherein the first domain and the second domain are separate from the end-user computer;

determining the present navigation location within the first frame using the navigation event;

initiating an automated help session in the second frame, the automated help session corresponding to the determined present navigation location, wherein the automated help session is provided by an automated agent through the second frame;

monitoring one or both of:

(i)   a plurality of subsequent navigation locations of the end-user within the first frame, or

(ii)   a plurality of subsequent navigation events initiated by the end-user within the first frame,

wherein the act of monitoring comprises passing the one or both of a plurality of subsequent navigation locations or a plurality of subsequent navigation events to the second frame, wherein the act of monitoring is performed at least in part by the automated agent; and displaying the first frame and the second frame in a single web page at the end-user computer.

38. The method of claim 37, further comprising:

    receiving data that was collected from the end-user in the automated help session;

    initiating a live help session, wherein the live help session is provided by a live human agent; and

    passing the collected data to the live help session.

39. The method of claim 37, further comprising:

receiving data that was collected from an end-user in the first frame; and

passing the data collected in the first frame to the second frame.

40. The method of claim 37, wherein the first frame comprises a content frame.

41. The method of claim 37, further comprising:

passing a command from the automated help session to the first frame.

42. The method of claim 37, further comprising:

receiving data that was collected in the automated help session; and

passing the data to the first frame.

43. The method of claim 38, further comprising:

receiving data that was collected in the live help session; and

passing the data to the first frame.

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44. The method of claim 38, further comprising:

receiving data that was collected from the end-user in the second frame; and

passing the data to the live help session.

45. A computerized method for providing user support, the method comprising:

passing, at an end-user computer, a navigation event from a first frame of a Web page originating from a first Internet domain to a second frame of the Web page originating from a second Internet domain, wherein the first Internet domain and the second Internet domain are distinct from the end-user computer;

determining the present navigation location within the first frame using the navigation event;

receiving automated help session content from the second Internet domain;

providing a help session in the second frame at the end-user computer, the automated help session corresponding to the determined present navigation location, wherein the automated help session is provided by an automated agent, wherein the act of providing a help session comprises one or both of:

    (i)   monitoring a plurality of subsequent navigation locations of the end-user within the first frame, or

    (ii)   monitoring a plurality of subsequent navigation events initiated by the end-user within the first frame; and

displaying the first frame and the second frame in the Web page at the end-user computer.

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46. The method of claim 45, further comprising:

    receiving data that was collected from the user in the automated help session;

    initiating a live help session, wherein the live help session is provided by a live human agent; and

    passing the collected data to the live help session.

47. The method of claim 45, further comprising:

    receiving data that was collected from an end-user in the first frame; and

    passing the data collected in the first frame to the second frame.

48. The method of claim 45, wherein the first frame comprises a content frame.

49. The method of claim 45, further comprising:

    passing a command from the automated help session to the first frame.

50. The method of claim 45, further comprising:

    receiving data that was collected in the automated help session; and

    passing the data to the first frame.

51. The method of claim 46, further comprising:

    receiving data that was collected in the live help session; and

    passing the data to the first frame.

52.   The method of claim 46, further comprising:

receiving data that was collected from the end-user in the second frame; and

passing the data to the live help session.

53.   A computerized method for providing user support at an end-user's computer, the method comprising:

passing, at the end-user's computer, a navigation event from a first frame originating from a first Internet domain to a second frame originating from a second Internet domain, wherein the first frame and the second frame are contained within a single Web page that is subject to a consistent page domain security requirement;

determining the present navigation location within the first frame using the navigation event;

providing an automated help session in the second frame at the end-user's computer, the automated help session corresponding to the determined present navigation location, wherein the automated help session is provided at least in part by an automated agent, wherein the act of providing an automated help session comprises:

(i)   monitoring navigation activities of the end-user within the first frame,

(ii) passing data from the second frame to the first frame, and

(iii) passing data from the first frame to the second frame; and

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displaying the first frame and the second frame in the single Web page at the end-user computer;

wherein the end-user's computer, the first Internet domain, and the second Internet domain are separate domains.

54. The method of claim 38, further comprising:

gathering help data associated with the live help session;

updating a knowledge database with the help data; and

using the help data from the updated knowledge database in a subsequent automated help session to provide assistance to the end-user.

55. The method of claim 37, wherein the first domain is associated with a first address, wherein the second domain is associated with a second address, the method further comprising masking one or both of the first or second addresses to create an appearance that the first and second addresses are the same address.

56. The method of claim 37, further comprising receiving a request from the end-user for assistance, wherein the act of initiating an automated help session is performed in response to receiving the request from the end-user for assistance.

IX.   EVIDENCE APPENDIX

None.

X.   <u>RELATED PROCEEDINGS APPENDIX</u>

REQUEST FOR A PRE-APPEAL CONFERENCE AND PANEL DECISION REGARDING
RELATED CASE 09/944,836

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,836	08/31/2001	Daniel Keele Burgin	1160215/0531072	3316

26874   7590   10/18/2007
FROST BROWN TODD, LLC
2200 PNC CENTER
201 E. FIFTH STREET
CINCINNATI, OH 45202

EXAMINER
TRAN, MYLINH T

ART UNIT	PAPER NUMBER
2179	

MAIL DATE	DELIVERY MODE
10/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination	
(barcode)	09/944,836	BURGIN ET AL.	
		Art Unit	
	Mylinh T. Tran	2179	
Document Code - AP.PRE.DEC			

Notice of Panel Decision from Pre-Appeal Brief Review

(barcode)

This is in response to the Pre-Appeal Brief Request for Review filed <u>12/18/06</u>.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

    ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
    ☐ The request does not include reasons why a review is appropriate.
    ☐ A proposed amendment is included with the Pre-Appeal Brief request.
    ☐ Other: .

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☐ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

    ☐ The panel has determined the status of the claim(s) is as follows:
    Claim(s) allowed: _____.
    Claim(s) objected to: _____.
    Claim(s) rejected: _____.
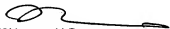   Claim(s) withdrawn from consideration: _____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☒ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) *Mylinh T. Tran*.

(2) *Weilun Lo*.

(3)*Lynne H Browne*.
   Appeal Practice Specialist, TQAS.

(4)_____.

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant:	Burgin, et al.	:	Atty. Ref:	1160215-0531072
Serial No.	09/944,836	:	Group Art Unit:	2179
Filed:	August 31, 2001	:	Examiner:	Mylinh Tran
For:	SYSTEM AND METHOD FOR AUTOMATED END USER SUPPORT			

ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW
In accordance with 1296 Off. Gaz. Pat. Office 67 (July 12, 2005)

Mail Stop AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Final Office Action dated August 24, 2006 ("Final Office Action") rejected claims 1-7, 9-20, 22-25, 27 and 28 as obvious over U.S. 2004/0088345 ("Zellner") in view of U.S. 6,658,464 ("Reisman"). However, at least one essential element needed for a prima facie case of obviousness was absent from the rejection of each independent claim, claims 1, 13, 20, and 25. Additionally, the Final Office Action did not address each limitation recited in the pending dependent claims. Therefore, applicants request that the panel withdraw the Final Office Action's rejections, and either re-open prosecution on the merits or allow pending claims. The concise arguments for which review is requested are set forth below.

Claim 1

The Final Office Action's rejection of claim 1 is a result of a clear legal error because it is based on a reference which is not analogous to the applicants' invention. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."[1] The present claims are in the field of automated end user support systems,[2] and are particularly directed to addressing the

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[1] MPEP § 2141.01(a) citing *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).
[2] U.S. Application 09/944,836, ¶ 3.

problem of poor customer experiences using ecommerce web sites.[3] By contrast, Zellner is in the field of "emergency reporting services,"[4] and its subject matter is directed to "offer[ing] an emergency reporting device that is capable of reporting a user's need for emergency help using TCP/IP message packets sent over the Internet to the ESC 12…[and] a subscription-based or usage-based emergency reporting service using TCP/IP messaging over the Internet."[5] These are not reasonably analogous fields of subject matters for at least the reason that automated end user support is used to minimize the necessity for human beings to be involved in an interaction,[6] while TCP/IP based emergency reporting services are used to ensure that a human is involved in an interaction as fast as possible.[7]

Further, to the extent that Zellner is considered analogous to the present invention, the Final Office Action did not show a proper motivation to modify Zellner with the teachings of Reisman in making the obviousness rejection of claim 1. When a claim is rejected as obvious, the reference cited must be modified to meet that claim.[8] The Examiner has the responsibility of showing that the prior art provides some motivation to make that modification.[9] That showing must include actual evidence of a suggestion, teaching or motivation to combine prior art references.[10] In rejecting claim 1, the Examiner conceded that Zellner does not teach or suggest encoding a present navigation link so that it appears to be associated with a second domain associated with a support location remote relative to the end user, limitations which are recited in the fourth and fifth clauses of claim 1. The Examiner then stated that Reisman teaches those limitations, and that "Motivation [for one of ordinary skill in the art at the time of the invention to combine Reisman and Zellner] would have been to provide the end user with an interactive and intelligent support session."[11] However, the Examiner did not identify *any* evidence in support of the statement regarding motivation to combine. This is a clear error of law, as the Federal Circuit has explicitly stated that "[b]road conclusory statements regarding the teaching of references, standing alone, simply *are not evidence*."[12] If this were not the case, then it would be possible to reject an invention as obvious by using "the claimed invention itself as a blueprint for piecing

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[3] U.S. Application 09/944,836, ¶ 4.
[4] Zellner, ¶ 4.
[5] Zellner, ¶ 12.
[6] U.S. Application 09/944,836, ¶¶ 5-6.
[7] For example, Zellner, ¶ 62, teaches commencing relief efforts by dispatching medical workers and firefighters.
[8] MPEP § 706.02(IV)
[9] MPEP § 2142.
[10] *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).
[11] Final Office Action mailed 8/24/06 at 4.
[12] *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (emphasis added).

together elements in the prior art to defeat the patentability of the claimed invention."[13] Therefore, the rejection of claim 1 is clearly insufficient for at least the following reasons:

1)   The Final Office Action based its obviousness rejection of claim 1 on a reference which is neither in the field of applicants' endeavor, nor pertinent to the problem with which the applicants were concerned; and

2)   The Final Office Action's asserted motivation to combine the teachings of Zellner and Reisman consisted of an unsupported conclusory statement and was not accompanied by the actual evidence necessary to make out a prima facie case of obviousness.

<div align="center">Claim 13</div>

The Final Office Action did not show that the combination of Zellner and Reisman taught or suggested "an annotation server" as is recited in the fourth and fifth clauses of claim 13. A requirement for a prima facie case of obviousness is that all claim limitations must be taught or suggested by the prior art.[14] In response to a previous office action, applicants specifically highlighted the limitations of the fourth and fifth clauses of claim 13 dealing with an annotation server as not being taught or suggested in the prior art.[15] However, rather than showing that either Zellner or Reisman teach or suggest an "annotation server," the Final Office Action simply rejected claim 13 in a group with claims 1, 19, 20 and 25, none of which include an "annotation server" as recited in claim 13. Additionally, because the Final Office Action combined its treatment of claims 1 and 13, the rejection of claim 13 suffers from the same infirmities set forth above regarding claim 1. Therefore, the rejection of claim 13 based on the combination of Zellner and Reisman is clearly insufficient for at least the following reasons:

1)   The Final Office Action did not make out a prima facie case of obviousness because it did not address the "annotation server" as recited in the fourth and fifth clauses of claim 13; and

2)   The weaknesses of the rejection of claim 1 – that Zellner is non-analogous art relative to the applicants' invention and that the Final Office Action provided no evidence of a motivation to modify the prior art – apply equally to claim 13 because the Final Office Action's treatment of claim 13 was combined with its treatment of claim 1.

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[13] *In re Rouffet* 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).
[14] MPEP § 2143.03, ¶ 1 citing *In re Royka*, 490 F.2d 981 (CCPA 1974).
[15] *See* Response to Office Action mailed 12/15/2005, page 3.

<u>Claims 20 and 25</u>

The weaknesses set forth above regarding the rejection of claim 1 apply equally to claims 20 and 25. As noted previously, the Final Office Action combined its treatment of claims 1, 13, 19, 20 and 25. Therefore, the rejections of claims 20 and 25 are clearly insufficient for at least the reasons set forth above regarding claim 1.

<u>Claims 6, 9, 10, and 16</u>

The Final Office Action simply did not address several limitations recited in the pending dependent claims. For example, dependent claim 6 recites the limitations of "wherein the content corresponding to the decoded embedded navigation link is received from the content location," but those limitations were simply not mentioned in the Final Office Action's treatment of that claim.[16] The Final Office Action similarly did not address the limitations of "wherein the embedded navigation link is associated with a first transport protocol and the end-user support is associated with a second transport protocol" from claim 9,[17] of "wherein the embedded navigation link is a first embedded navigation link and wherein the first navigation link is associated with the first domain and wherein the retrieved content includes a second navigation link associated with the second domain" from claim 10,[18] and of "a skills module in communication with the roles module," from claim 16.[19] Additionally, applicants note that, as set forth above, the Final Office Action did not make out a prima facie case of obviousness for any of the independent claims in the application, and therefore that, simply by virtue of their dependency, each dependent claim is also non-obvious.[20] Therefore, the rejections of claims 6, 9, 10 and 16 are clearly insufficient for at least the following reasons:

1) The Final Office Action's rejections of claims 6, 9, 10 and 16 simply did not address certain limitations recited in those claims; and

2) Because of their dependent status, claims 6, 9, 10 and 16 are patentable for at least the reasons set forth above regarding their respective independent claims.

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[16] *See* Final Office Action, page 6.
[17] *See* Final Office Action, page 6.
[18] *See* Final Office Action, page 7.
[19] *See* Final Office Action, page 8.
[20] MPEP § 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." quoting *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988)).

<div style="text-align: center;">Conclusion</div>

For at least the reasons above, it is respectfully submitted that the rejections of the pending claims as obvious over Zellner in view of Reisman are clearly insufficient. Therefore, the applicants request that the panel withdraw those rejections and either allow the pending claims in their current form or re-open prosecution on the merits.

The applicants note that due to the length and content restrictions of the pre-appeal review program, this paper does not include all arguments related to the pending claims. To the extent that applicants have not addressed certain aspects of the present rejection, please do not construe the same as an admission as to the merits of the rejections. Indeed, applicants reserve all rights with respect to arguments not explicitly raised herein.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

Daniel Keele Burgin, et al.

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